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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/679,659	10/06/2003	Tae-Kyung Kim	02-ASD-270 (EM)	4114
200	7590	03/22/2006	EXAMINER	
EATON CORPORATION EATON CENTER 1111 SUPERIOR AVENUE CLEVELAND, OH 44114			ORTIZ, ANGELA Y	
			ART UNIT	PAPER NUMBER
			1732	

DATE MAILED: 03/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

CW

Office Action Summary	Application No. 10/679,659	Applicant(s) KIM, TAE-KYUNG	
	Examiner Angela Ortiz	Art Unit 1732	

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 3-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parrish et al., USP 3,029,730 for the reasons cited in the previous office action.

The cited reference substantially teaches the basic claimed method of sealing a gap between two members, shell 10 and plate 18, which are assembled to form a composite product. Shell 10 and plate 18 are assembled but separated by two sealing gaskets 14. The assembly is placed between two mold plates 12 and 16 for compressing the assembly during curing of the sealant material. A liquid curable sealant material 24 is provided through the mold and into the cavity between the assembled members. After the resin has cured, the mold is opened and the composite product is removed from the mold. Note that during application of the sealant, pressure is continuously applied until the sealant is cured. See col. 3, lines 5-75.

The reference does not set forth the intended use of sealing a gasketed joint per se, as set forth in the preamble of the claim, or the step of placing the second gasket adjacent the first gasket.

The preamble has not been given patentable weight in this rejection, as the steps performed do not reflect back to the first line of the claim.

With respect to the claimed step of placing the gaskets adjacent, note that adjacent is a term of relativity and such is deemed met by the art in that the area between the gaskets similarly defines a cavity (or pocket) to be filled by the sealant material. It would have been obvious to one of ordinary skill in the art at the time the invention was made to so place the gaskets in any conventional manner to create a boundary for receiving the molding resin material as desired.

With respect to claim 3, see col. 3, line 11.

With respect to claim 4, note that while other materials are shown in the reference, the use of silicone gels is conventional in the art and would have been an obvious alternative to those set forth in the reference, as they yield similar results. See col. 4, lines 48-55.

With respect to claim 5, see col. 3, line 26.

With respect to claims 6-7, note that the reference teaches that the gaskets can be placed as desired at col. 3, lines 65-72; it would have been obvious to form a pocket of any conventional design as such is well within the level of ordinary skill in the art.

With respect to claim 8, note that the reference teaches using rubber gaskets at col. 2, line 66; such materials are well known in the art for having stiffer compressibility properties and it would have been obvious to one of ordinary skill in the art at the time the invention was made to include as a gasket choice for achieving the desired compressibility.

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Claims 1, 2, 3, 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hill et al., USP 6,431,549 for the reasons cited in the previous office action.

The cited reference substantially teaches the basic claimed method of sealing joints between two components, wherein the components are readable on the claimed members. First and second components are provided with a plurality of openings, wherein the openings cooperate to align the components through the use of pins and other means. Between the components a gap is formed and a plurality of sealant carrier members, readable on the claimed gaskets, may be provided. The sealant carrier members may be sized and shaped to follow the path of an elongated gap that exists between the first and second components. In the method, as depicted in figure 11, component 24 is assembled to component 14 by providing sealant strips 204 within the gap between the components. A compressible sealant 284 is provided and spread to seal a gap 28 between the components. The preferred sealant used is urethane, which is heat curable, see col. 11, lines 55-65. See also col. 13, line 50 to col. 14, line 15.

The reference does not set forth forming a pocket between the edge of a first and second gasket as claimed, per se.

Note that figures 9 and 10 show an embodiment of the strip having a pattern of openings within the strip, wherein openings are formed for receiving the sealant material to be applied. It would have been obvious to one of ordinary skill in the art at the time the invention was made to so include forming a pocket as claimed, in view of the

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patterned openings shown in the applied reference, for receiving the sealant material as shown.

With respect to claims 2-3, note that the reference teaches applying the sealant in the form of a bead at col. 10, lines 5-13. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include any conventional bead form, including pellet or semi-liquid, for equivalently applying the sealant material as desired.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-5 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 5 of copending Application No. 10/673,807. Although the conflicting claims are not identical, they are not patentably distinct from each other because both set forth a method of

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sealing a first and second member by molding sealant material between two gaskets on at least one member.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

Applicant's arguments filed January 5, 2005 have been fully considered but they are not persuasive.

Applicant argues that the cited reference to Parrish does not show two gaskets and thus does not make obvious a gasketed joint as claimed.

This is not persuasive. When claim 1 is given its broadest reasonable interpretation, it reads on molding within a boundary between two edges of a gasket or gaskets. The applied reference to Parrish shows two edges with a cavity formed inbetween, and this cavity is filled with a sealant material and cured as claimed. Note that the claim does not set forth that the pocket is not bound; this pocket is readable on the cavity formed in the applied prior art reference. To so include additional gaskets would have been obvious for forming a smaller cavity to mold the sealant within.

Applicant argues that the Hill reference shows carrier strips and not gaskets, because the carrier strips cannot perform a sealing function.

The reference teaches at col. 10, lines 15-50:

15 Preferably, as will be understood with reference to bead
280, adjacent to openings in the strips, the sealant is position-
ed between the openings through the strip and the
outside edge 212 of the strip. As a result, in the region of the
fasteners which pass through these openings, sealant is
10 positioned between the fastener and the exterior of the
vehicle at the joint.

As explained more fully below, the sealant may be applied
in a non-uniform manner to the carrier strips. More
specifically, the volume of applied sealant may be selec-
15 tively varied. As a specific example, adjacent to the ends of
the strips, a thicker or higher volume of sealant may be
applied. This can be accomplished, for example, by slowing
the movement of a sealant applicator at such location while
maintaining the sealant flow rate so that a greater volume of
sealant is applied at such location. Consequently, when
10 sealant strips are applied end to end (for example, see FIG.
7 for the driver's side of a truck) gaps may exist between the
ends of adjacent strips. The excess sealant at these locations
flows into any such gaps and seals these locations. As
previously mentioned, these strips may be applied with ends
15 overlapping one another without affecting the seal, although
in this case the volume of sealant at the ends would typically
be reduced to avoid the application of excess sealant at such
locations. Also, additional sealant may be applied at loca-
tions and in a desired pattern at other locations, for example
10 where a recess or gap exists in the joint components being
sealed. In addition, as can be seen in FIG. 6, in this example,
at the locations of the fastener receiving openings, a lesser
quantity of sealant may be applied. At such locations, a
shorter distance exists between the outer edge of the joint
15 and the location at which the sealant is applied in compari-
son to the distance at locations between the openings. By
reducing the amount of sealant that is applied at such
fastener locations, the problem of excess sealant being
squeezed outwardly from the joint at such locations is
10 minimized. However, enough sealant is applied to seal the
joint at such locations.

The strips act as boundaries for the fluent sealant material. While these strips are porous, their sealing impact is not hindered. A gap is provided between the strips for receiving sealant material as described, and act as gaskets as claimed. Applicant has not set forth a material limitation for the gaskets to set them apart from porous materials, thus the argument regarding the materials is not persuasive.

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Note that the terminal disclaimer filed was not approved as the attorney signing the disclaimer is not of record.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Angela Ortiz whose telephone number is 571-272-1206. The examiner can normally be reached on Monday-Thursday 9:00-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianni can be reached on 571-272-1196. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Angela Ortiz
Primary Examiner
Art Unit 1732

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